

## **REMARKS**

### **Status of the Claims**

Claims 25, 30 – 32, and 34 – 43 were pending. Claims 25, 30 – 32, and 34 – 43 are rejected. Claims 25 and 34 are being amended. Claims 44 – 47 are being newly added in this amendment. Claims 36 and 37 are being presented with the claim identifier “previously presented” as the Examiner indicates that claims 25, 30 – 32, and 34 – 43 are examined on the merits in this Office Action, and the Examiner did not withdraw these claims even though they are directed to non-elected species. Claims 25, 30 – 32, and 34 – 47 will be pending upon entry of this amendment.

No new matter is being introduced. Amendments to claims 25 and 34 are amendments to claim form. Claims 44 and 45 are supported at least by Example 1 in the specification, beginning at line 16 on page 8. Claim 46 is supported at least by Example 6 in the specification, beginning at line 1 on page 11. Claim 47 is supported at least by Example 7 in the specification, beginning at line 13 on page 11.

Reconsideration is respectfully requested.

### ***Claim Rejections – 35 U.S.C. § 103***

#### **First 35 U.S.C. § 103 Rejection**

The Examiner rejects claims 25, 30 – 32, and 34 – 43 under 35 U.S.C. § 103(a) as being unpatentable over Hunter *et al.*, United States Patent No. 5,886,026 (Hunter), in view of Hossainy *et al.*, United States Patent Application Publication No. 2001/0014717 (Hossainy).

#### **The Examiner’s Position**

The Examiner’s position with respect to Hunter was previously presented. However, with respect to claims 25, 30 – 32 and 34 – 43, the Examiner admits that “Hunter et al. do not teach a method of coating wherein the polymeric material dissolved in solvent is ethylene-vinyl alcohol copolymer.” Thus, the Examiner cites Hossainy, which, in the Examiner’s view, teaches “a coating composition wherein sufficient amounts of active ingredient are dispersed in a blended composition of ethylene-vinyl alcohol copolymer and solvent.” The Examiner concludes that Applicants’ claims would have been obvious to one of skill in the art based upon the disclosures of Hunter and Hossainy.

### Applicants' Response

First, Hossainy is disqualified as prior art. Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. §103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention, “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” (see the Manual of Patent Examining Procedure (MPEP), 8<sup>th</sup> Edition, § 706.02(l)(1)(I)) A statement of an attorney of record can be sufficient evidence to establish common ownership. (see MPEP § 706.02(l)(2)(II))

As established by the enclosed Statement of Common Ownership, at the time the invention of the current application was made, the inventions of the current application and Hossainy were owned by, or subject to an obligation of assignment to, Advanced Cardiovascular Systems, Inc., a California corporation. Abbott Cardiovascular Systems Inc. purchased the vascular device division and all relevant intellectual property, including both of the above applications, of Advanced Cardiovascular Systems, Inc. (Guidant Corporation) in May 2006. Since Applicant has established common ownership, Hossainy is disqualified as prior art and should be removed as a reference.

Second, Applicants' position with respect to Hunter was presented in the March 15, 2010 Response to the October 14, 2009 Final Office Action.

Thus, it is Applicants' position that the Examiner has not established a *prima facie* case of obviousness.

There exists another reason for the patentability of claim 38. With respect to the feature of claim 38, the Examiner relies upon Hossainy for the disclosure of the feature of claim 38. However, as Hossainy is disqualified, and the Examiner admits that Hunter does not disclose the ethylene-vinyl alcohol copolymer, the feature of claim 38 is not taught, or suggested, by any of the references. A *prima facie* case of obviousness at least requires that each element is taught, or suggested, by the references. Therefore, there is an additional reason for the patentability of claim 38.

### Second 35 U.S.C. § 103 Rejection

The Examiner rejects claims 25, 30 – 32, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Hunter.

The Examiner's Position

The Examiner's position with respect to Hunter was presented previously.

Applicants' Response

Applicants' position with respect to Hunter was presented in the March 15, 2010 Response to the October 14, 2009 Final Office Action. Therefore, it is Applicants' position that the Examiner has not established a *prima facie* case of obviousness.

***Patentability of New Claims***

New claims 44 – 47 depend from claim 1, and are therefore patentable for at least the same reasons that claim 1 is patentable.

**Conclusion**

In light of the foregoing claim amendments and remarks, this application is considered to be in condition for allowance. Applicants respectfully request the allowance of pending claims 25, 30 – 32, and 34 – 47.

If necessary to ensure a timely response, this paper should be considered as a petition for an Extension of Time sufficient to provide a timely response. The undersigned authorizes the Commissioner to charge any fees that may be required, or credit any overpayment to be made, to the **Squire, Sanders & Dempsey (US) LLP Deposit Account No. 07-1850**.

Should the Examiner have any questions regarding this communication, the Examiner is invited to contact the undersigned at the telephone number shown below.

Respectfully submitted,

Dated: Monday, September 12, 2011  
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